

Applicants : Winthrop Childers
Patent No. : n/a
Issued : n/a
Serial No. : 10/645,185
Filed : 08/21/2003

Attorney's Docket No.: 200208971-1
Page 9 of 13

REMARKS

In the present Office Action, the Examiner objected to claims 1, 14 and 21 for various informalities and claims 1, 2-4, 8, 14, 18-20, 23-29 and 31-33 under 35 U.S.C § 112. Applicant has modified the claims to address these informalities as indicated above and no new matter has been introduced. Accordingly, Applicant respectfully submits that these objections and rejections should be withdrawn.

Further, the Examiner rejected claims 1, 8, 15, 29 and 31 under 35 U.S.C § 103(a) citing Dorenbosch et al (US 2004/0064355) in view of Lee et al (US 2004/0039723). In the case of claim 8, 15, 29 and 31 the Examiner further alleged 35 U.S.C § 103(a) in light of one or more of additional cited art namely Lee [US/2006/0010317], Johnson [US 7,143,177] and Hamid [US 2006/0288229].

Upon careful inspection, the Applicant has noted that he has a conception date that precedes the critical filing date of October 1, 2002 for Dorenbosch. According to Rule 37 CFR 1.131, the Applicant can eliminate Dorenbosch as a reference by providing a declaration with satisfactory evidence of facts that he has a conception date prior to the aforementioned critical filing date. This declaration also serves as satisfactory evidence that Lee et al should also be eliminated as a possible reference given the effective filing date of Lee is indeed April 3, 2003. Applicant respectfully submits that the attached declaration under Rule 37 CFR 1.131 achieves

Applicants : Winthrop Childers
Patent No. : n/a
Issued : n/a
Serial No. : 10/645,185
Filed : 08/21/2003

Attorney's Docket No.: 200208971-1
Page 10 of 13

this objective and therefore on this basis both the cited art of Dorenbosch and Lee et al should be withdrawn as references.

Indeed, without Dorenbosch and/or Lee et al, the Examiner has failed to establish the *prima facie* case under 35 U.S.C. § 103(a) for rejecting claims 1, 8, 15, 29, and 31. It is well settled that “[t]he examiner bears the initial burden of factually supporting any *prima facie* case of obviousness. Moreover, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). See also MPEP § 2143.03. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.”

M.P.E.P. § 2142.

Even if only Dorenbosch is eliminated, Lee et al alone does not teach or suggest “a reservation system server capable of communicating over a network with a client that fulfills projector and venue reservation requests received via the network and coordinates a transport and a storage of presentation data received via the network” as recited in amended claim 1.

Applicants: Winthrop Childers
Patent No.: n/a
Issued: n/a
Serial No.: 10/645,185
Filed: 08/21/2003

Attorney's Docket No.: 200208971-1
Page 11 of 13

Further, the cited art of Lee alone does not teach or suggest "selecting the presentation venue having one or more available projectors in accordance with a venue selection criteria for a presentation and associated presentation data" and "selecting a projector according to a projector selection criteria for the presentation and the one or more available projectors at the venue" as recited in amended claim 8. Lee alone also does not teach or suggest "means for selecting a presentation venue according to a venue selection criteria for a presentation" and "means for selecting a projector according to a projector selection criteria for the presentation and one or more projectors available at the venue" as recited in amended claim 29. Likewise, the cited art of Johnson does not teach or suggest "receiving a projector and presentation venue reservation request" as recited in claim 15.

For at least the aforementioned reasons, Applicant respectfully requests withdrawing the rejections of independent claims 1, 8, 15, 29 and 31 under 35 U.S.C § 103(a). Dependent claims 2-7, 9-14, 16-28 and 32-33 are not only allowable on their own but by virtue of being dependent from allowable independent claims.

It is also the case that without Lee et al, the Examiner has failed to establish a *prima facie* case under 35 U.S.C § 103(a) for rejecting claim 30. Specifically, the combination of Johnson in view of Hamid does not teach or suggest "means for receiving presentation data from a projector reservation client" and "means for ensuring availability of proper presentation software" as

Applicants: Winthrop Childers
Patent No.: n/a
Issued: n/a
Serial No.: 10/645,185
Filed: 08/21/2003

Attorney's Docket No.: 200208971-1
Page 12 of 13

recited in claim 30. Accordingly, the Applicant also respectfully requests withdrawing the rejection of independent claim 30 under 35 U.S.C. § 103(a).

Even if Lee et al were considered a proper reference, the Examiner has not identified a reason to combine the elements of Lee in view of Johnson and Hamid in the manner recited in claim 30 in view of a person of ordinary skill in the relevant field. The Supreme Court in KSR stated that it is “important [for an examiner] to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350, slip op. at 14 (U.S. April 30, 2007). The Court indicated that there should be an “explicit” analysis regarding “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* (emphasis added). Further, the Court did not reject the use of “teaching, suggestion, or motivation” test as a factor in the obviousness analysis, but rather stated that this test may be indicative of non-obviousness under 35 U.S.C. § 103. *Id.* at 14-15. Indeed, the only reason provided for combining the elements in the manner received in claim 30 was directly from the specification of the instant application and not from a person of ordinary skill in the relevant field. In particular, one of several new benefits associated with the claimed invention and mentioned in paragraphs 20, 21, 22 and 41 includes the Examiner’s reason that “the user does not have to worry about not being prepared for the presentation”.

Applicants: Winthrop Childers
Patent No.: n/a
Issued: n/a
Serial No.: 10/645,185
Filed: 08/21/2003

Attorney's Docket No.: 200208971-1
Page 13 of 13

In summary, the Applicant respectfully requests allowance of independent claims 1, 8, 15, 29, 30 and 31 for at least the aforementioned reasons. Further, defendant claims 2-7, 9-14, 16-28 and 32-33 should not only be allowed on their own but by virtue of their dependency on their respective allowable independent claims.

The Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Leland Wiesner, Applicants' Attorney at (650) 853-1113 so that such issues may be resolved as expeditiously as possible.

For at least these reasons this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

08/20/2007
Date


Leland Wiesner
Attorney/Agent for Applicant(s)
Reg. No. 39424

Leland Wiesner, Attorney
Wiesner & Associates
366 Cambridge Avenue
Palo Alto, California 94306 Tel. (650) 853-1113